REMARKS/ARGUMENTS

These remarks are in response to the Office Action mailed March 8, 2005. No fee is due for the addition of any new claims.

Claims 32, 33, 35-40 and 45-56 were pending in the Application prior to the outstanding Office Action dated March 8, 2005 (hereafter, "latest Office Action"). In the latest Office Action, the Examiner rejected Claims 32, 33, 35-40 and 45-56 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,317,797 ("*Clark*") in view of U.S. Patent No. 5,684,990 ("*Boothby*"). The present Reply amends Claim 32, leaving for the Examiner's present consideration Claims 32, 33, 35-40, and 45-56. Reconsideration of the rejections is requested.

I.   Response to Claim Objections Under 35 U.S.C. §103(a)

Claims 32, 33, 35-40 and 45-56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Clark et al.* (U.S. Patent No. 6,317,797), in view of *Boothby* (U.S. Patent No. 5,684,990). We note that the latest Office Action (p. 2, section 5) incorporates by reference all arguments made in the Final Office Action dated February 24, 2004 (hereafter, "Final Office Action").

To expedite approval of the claims, Claim 32 has been amended to emphasize that the selection of a file type to monitor is received from a user, and that the limitations of transferring said modified file to said second computer and replacing said identified file on said second computer with said modified file on said first computer are performed automatically. The amendments are supported by the specification.

It is respectfully submitted that *Clark* and *Boothby*, either alone or in combination, fail to teach or suggest all of the limitations of amended Claims 32, 33, 35-40 and 45-56 and cannot render these claims obvious.

A.   Claims 32, 33 and 35

Clark and *Boothby,* alone or in combination, do not teach or suggest all of the limitations of Claims 32, 33 and 35, as amended. Amended claim 32 includes, among other limitations, "recording a file identification responsive to a modification to a file of said selected file type." The latest Office Action suggests that this limitation is taught by *Boothby*. Applicants respectfully disagree. The latest Office Action cites *Boothby* (col. 1, line 55 to col. 2, line 4) as teaching that "a technique for

synchronizing disparate databases of different computers is achieved by using unique IDs assigned when a record is created, and the software is able to use the unique Ids to compare the contents of corresponding data records in the two databases." However, as stated in the quoted limitation, *Boothby* teaches known techniques for synchronizing *databases*. Amended claims 32, 33, and 35, by contrast, address a method for synchronizing a *file type* between a first *computer* and a second *computer*. Amended claims 32, 33, and 35 are not limited to synchronizing databases and thus are not taught by *Boothby*. Moreover, *Boothby* (column 1, lines 55-58) teaches that database synchronization techniques "generally depend on the databases having been specially designed to facilitate synchronization." Claims 32, 33, and 35, by contrast, do not depend on any requirement of special design. Moreover, amended claims 32, 33, and 35 are directed to *any* selected computer file type.

Furthermore, *Boothby* teaches setting a status indicator <u>after a comparison</u> of records rather than "recording a file identification responsive to a modification to a file of said selected file type," as recited in amended claim 32. *Boothby*, col. 5, lines 53-55 and 63-65. Thus the status indicator of *Boothby* is set after a comparison, whereas no comparison is required in amended claim 32 before "recording a file identification." *Boothby* thus does not teach "recording a file identification responsive to a modification to a file of said selected file type."

The Final Office Action suggested that this limitation is taught by *Clark*. Applicants respectfully disagree. *Clark* (col. 16, lines 3-7) recites, A[i]f the dates or times are different, control proceeds to step 640, where the first different file is indicated. Control proceeds to step 642 where the two files are scanned to determine if there are any differences. Control proceeds to step 644 to determine if any differences were found."

The requirement in *Clark* (col. 16, lines 3-7) that "[c]ontrol proceeds to step 640, where the first different file is indicated" refers to reference numeral 640 of Fig. 12, which states "point to first file." *Id.* This cited language of *Clark* merely references pointing to the first file having different times associated with the respective versions of the file in order to begin the next operations of the method disclosed in Fig. 12. The cited portion does not mention recording at all, much less "recording a file identification," as recited in amended claim 32. *Clark* merely discloses passing control between two steps described with respect to Fig. 12. This language does not teach or suggest

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"recording a file identification responsive to a modification to a file of said selected file type," as recited in amended Claim 32.

Moreover, the method taught by *Clark* does not illustrate a need for "recording a file identification responsive to a modification to a file of said selected file type," as recited in Amended claim 32. The method of *Clark* begins by developing "the various host and handheld file names, types and directories." *Id.*, col. 15, lines 62-64. After developing, it is determined "if the dates or times are different for the particular files. If not, control proceeds to step 636 where a synchronization flag is set." *Id.*, col. 15, lines 65-67. Thus, *Clark* teaches determining if the dates and times are different for all the developed files. Amended claim 32, however, recites "recording a file identification responsive to a modification to a file of said selected file type," such that only files that have been modified need to be compared to determine which is more recent.

Boothby also fails to teach or suggest "recording a file identification responsive to a modification to a file of said selected file type," as recited in Amended claim 32, and thus, fails to cure the deficiency identified in *Clark.* In *Boothby*, "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file (step 205)." *Boothby*, col. 5, lines 63-65. After retrieval of the records, "all mapped fields of the handheld record and status file record are compared." *Id.*, col. 6, lines 53-55. After the comparison, a status indicator is set, based on a matching of the fields. *Id.* Thus, *Boothby* teaches setting a status indicator <u>after a comparison</u> of records rather than "recording a file identification responsive to a modification to a file of said selected file type," as recited in Amended claim 32. The status indicator of *Boothby* is set after a comparison, whereas no comparison is required in Amended claim 32 before "recording a file identification."

It is respectfully submitted that *Clark* and *Boothby*, either alone or in combination, fail to teach or suggest, "recording a file identification responsive to a modification to a file of said selected file type," as recited in Amended claim 32. These arguments were previously submitted in our Response E filed August 20, 2003, and then again in our Response G filed August 20, 2004, but were not addressed in detail in the Final Office Action nor in the latest Office Action.

Amended claim 32 also includes the limitation "determining, subsequent to said step of identifying and without user intervention, whether said modified file on said first computer is more

recent than said identified file on said second computer." *Clark* (604 of Fig. 11; col. 16, lines 8-12) was cited by the Final Office Action as disclosing this limitation. It is respectfully submitted that *Clark* does not teach or suggest this limitation.

The corresponding text to 604 of Fig. 11 teaches that "control proceeds to step 604 to determine if the files have different dates or times." *Clark*, col. 15, lines 48-50. Amended claim 32, however, recites "determining, ...whether said modified file on said first computer is more recent than said identified file on said second computer." (Emphasis added). *Clark* merely determines whether the files have different dates or times, not whether one is more recent than the other. *Clark* continues by explaining that if the dates and times are different, "control proceeds to step 606 where the handheld file is transmitted to the host computer, assuming that entry will be done only at the handheld computer H as this where the expenses are being incurred." *Id.* at lines 48-54. *Clark* assumes that entries are being done only at the handheld such that if the files have different dates and times, the handheld file is transmitted to the host computer. Thus, this portion of *Clark* does not teach "determining, subsequent to said step of identifying and without user intervention, whether said modified file on said first computer is more recent than said identified file on said second computer," as recited in Amended claim 32. Applicants therefore respectfully submit that *Clark* and *Boothby*, alone or in combination, fail to teach or suggest this limitation.

Amended claim 32 also includes the limitation, "transferring said modified file to said second computer and replacing said identified file on said second computer with said modified file on said first computer without user intervention, only if it is determined that said first date and time is more recent than said second date and time." *Clark* ("col. 15, lines 59 to col. 16, lines 27, particular col. 16, lines 19-23") is cited by the latest Office Action as disclosing this limitation. It is respectfully submitted that neither *Clark* or *Boothby*, alone or in combination, teach or suggest "automatically transferring said modified file to said second computer and automatically replacing said identified file on said second computer with said modified file on said first computer without user intervention, only if it is determined that said first date and time is more recent than said second date and time," as recited in amended claim 32.

Clark does not teach or suggest this limitation. *Clark* teaches determining if the dates or times are different, scanning the documents, adding files that are entirely new, and presenting edited

files <u>to the user</u> to make a decision. *Clark,* col. 16, lines 8-12. *Clark* teaches that "<u>the user selects</u> whether to keep the handheld or host or both files or merge the files." *Clark,* col. 16, lines 18-19. *Clark* (col. 16, lines 12-16) describes that "the particular differences are highlighted and shown to the user <u>so that he</u> can make a proper decision" (emphasis added).

The lines cited as particularly relevant by the latest Office Action (col. 16, lines 19-23) disclose, "In this manner the more recent or more accurate of the two can be obtained or if a conclusion cannot be reached both copies can be saved with different names or the files can be combined." Applicants respectfully note that this disclosure presents *alternate, possible* embodiments rather than the current claims' disclosure of a *single, definite* method for automatic synchronizing a file type between a first computer and a second computer. Applicants further respectfully note that, at most, *Clark* discloses a method by which a *user* may *manually* select a file, in marked contrast to the current claims' disclosure of a method by which the steps of transferring and replacing are performed *by the computer* and occur *automatically. Boothby* also does not teach or suggest "automatically transferring said modified file to said second computer and automatically replacing said identified file on said second computer with said modified file on said first computer without user intervention, only if it is determined that said first date and time is more recent than said second date and time," as recited in amended claim 32. As taught by *Boothby,* "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file." *Boothby,* col. 5, lines 63-65. Thus, *Boothby* teaches retrieving records and comparing them. Accordingly, *Boothby* does not teach "automatically transferring .... and automatically replacing ..., only if it is determined that said first date and time is more recent than said second date and time," as recited in amended claim 32. *Boothby* discloses only the retrieval of records and making a comparison of said records.

Applicants' arguments demonstrate that *Clark* and *Boothby,* either alone or in combination, do not teach or suggest all of the limitations of amended claim 32. Accordingly, amended claim 32 is believed patentable over *Clark* in view of *Boothby.* These arguments were previously submitted in our Response E filed August 20, 2003, and then again in our Response G filed August 20, 2004, but were not addressed in detail in the Final Office Action nor in the latest Office Action.

Claims 33 and 35 ultimately depend from claim 32 and should therefore be patentable for at least the reasons discussed above. It is further submitted that Claims 33 and 35 add their own limitations that render them patentable in their own right. Applicants reserve the right to argue those limitations should it become necessary in the future.

Accordingly, Claims 32, 33 and 35 are believed patentable under 35 U.S.C. § 103(a) over *Clark* in view of *Boothby* and withdrawal of the Examiner's rejections of Claims 32, 33 and 35 is requested.

B.   Claims 36-38

Clark and *Boothby,* alone or in combination, do not teach or suggest all of the limitations of Claims 36-38. Accordingly, Claims 36-38 are believed patentable over *Clark* in view of *Boothby.*

Claim 36 includes, among other limitations, "retrieving said item of information from said first computer, only if it is determined that said item of information stored on said first computer is more recent than said corresponding item of information stored on said second computer." The Final Office Action cited *Clark,* col. 3, lines 14-17, lines 31-34; col. 14, lines 41-60 for the disclosure of this limitation. It is respectfully submitted that *Clark* does not teach or suggest this limitation.

Clark, col. 3, lines 14-17 teach that when the handheld and host are actively connected, the handheld "automatically captures updated data in the host computer which is also contained in the handheld computer. In this manner, while the two are physically connected automatic synchronization of the data is performed in real time." This portion teaches automatic capture of data while two devices are connected. There is no teaching or suggestion of "retrieving said item of information from said first computer, only if it is determined that said item of information stored on said first computer is more recent than said corresponding item of information stored on said second computer," as recited in Claim 36 (emphasis added).

Clark, col. 3, lines 31-34 teach that "[i]nformation newly entered into the handheld computer is preferably automatically updated to the host computer as it is assumed that the user is the master of the information." This merely teaches updating the host computer with information entered into the handheld. Information is automatically updated to the host computer "as it is assumed that the user is the master of the information." *Id.* (emphasis added). Thus, information is updated in one direction based on an assumption. This does not teach or suggest "retrieving said item of information from

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said first computer, only if it is determined that said item of information stored on said first computer is more recent than said corresponding item of information stored on said second computer," as recited in Claim 36.

Col. 14, lines 41-60, teaches that "the appropriate host file and handheld file names are obtained to allow comparison. Control proceeds to step 554 to determine if the last dates or times of the two files are different." Thus, *Clark* teaches obtaining the host file and handheld file names and determining if the dates and times of the two files are different. As the Final Office Action stated, *Clark* teaches merely a "comparison to determine that the files obtained from the host computer is not previously stored on the handheld computer." Final Office Action, page 5, para. 2 (emphasis added). Obtaining and determining cannot teach or suggest "retrieving said item of information from said first computer, only if it is determined that said item of information stored on said first computer is more recent than said corresponding item of information stored on said second computer," as recited in Claim 36 (emphasis added). Claim 36 claims retrieving the information after making a determination, not obtaining information in order to make a determination as described by *Clark*.

Boothby also teaches to retrieve then make comparisons and thus, does not teach or suggest "retrieving said item of information from said first computer, only if it is determined that said item of information stored on said first computer is more recent than said corresponding item of information stored on said second computer," as recited in Claim 36. As taught by *Boothby*, "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file." *Boothby*, col. 5, lines 63-65.

Therefore, *Clark* and *Boothby*, either alone or in combination, do not teach or suggest each of the limitations of Claim 36. Accordingly, Claim 36 is believed patentable over *Clark* in view of *Boothby*. These arguments were previously submitted in our Response E filed August 20, 2003, and then again in our Response G filed August 20, 2004, but were not addressed in detail in the Final Office Action nor in the latest Office Action.

Claims 37 and 38 ultimately depend from Claim 36 and should therefore be patentable for at least the reasons discussed above. It is further submitted that Claims 37-38 add their own limitations that render them patentable in their own right. Applicants reserve the right to argue these limitations should it become necessary in the future.

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Accordingly, Claims 36-38 are believed patentable under 35 U.S.C. § 103(a) over *Clark* in view of *Boothby* and withdrawal of the Examiner's rejections of Claims 36-38 is requested.

C.   Claims 39-40

Clark and *Boothby*, alone or in combination, do not teach or suggest all of the limitations of Claims 39-40. Accordingly, Claims 39-40 are believed patentable over *Clark* in view of *Boothby*.

The Final Office Action stated that A[a]s to claim 39, all limitations have been addressed in the analysis of claim 36 above, and this claim is rejected on that basis.@ Page 5, para. 3

However, Claim 39 includes, among other limitations, "providing said item of information to said first computer, only if it is determined that said item of information stored on said second computer is more recent than said corresponding item of information stored on said first computer." This limitation does not appear in Claim 36, nor is it present in *Clark*. As stated above, *Clark* teaches obtaining host file and handheld file names, then determining if the dates and times of the two files are different. Accordingly, *Clark* does not teach or suggest "providing said item of information to said first computer, only if it is determined that said item of information stored on said second computer is more recent than said corresponding item of information stored on said first computer," as recited in Claim 39. As also discussed above, *Boothby* teaches that "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file." *Boothby*, col. 5, lines 63-65. Thus, *Boothby* does not teach or suggest this limitation of Claim 39.

Therefore, *Clark* and *Boothby*, either alone or in combination, do not teach or suggest each of the limitations of Claim 39. Accordingly, Claim 39 is believed patentable over *Clark* in view of *Boothby*. These arguments were previously submitted in our Response E filed August 20, 2003, and then again in our Response G filed August 20, 2004, but were not addressed in detail in the Final Office Action nor in the latest Office Action.

Claim 40 ultimately depends from Claim 39 and should therefore be patentable for at least the reasons discussed above. It is further submitted that Claim 40 adds its own limitations that render it patentable in its own right. Applicants reserve the right to argue these limitations should it become necessary in the future. Applicants reserve the right to argue these limitations should it become necessary in the future.

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Accordingly, Claims 39-40 are believed patentable under 35 U.S.C. § 103(a) over *Clark* in view of *Boothby* and the withdrawal of the Examiner's rejections of Claims 39-40 is requested.

D.   Claims 45-56

Neither *Clark* or *Boothby*, alone or in combination, teaches or suggests all of the limitations of Claims 45-56. Accordingly, Claims 45-56 are believed patentable over *Clark* in view of *Boothby*.

Claim 45 includes the limitation of "a user interface that prompts a determination whether at least one item of information stored on said first computing device should be synchronized with a second computing device." These amendments are supported by the specification (see, *e.g.*, p. 8, lines 5-13) and are intended to emphasize the feature of a prompt from the user interface to cause a determination as to whether to proceed with synchronization of at least one item of information stored on the first computing device.

Claim 45 includes, among other limitations, "a work monitor interface, including information identifying an occurrence of an event or activity on the first computing device." It is respectfully submitted that *Clark* and *Boothby*, either alone or in combination, fail to teach or suggest this limitation. The Final Office Action conceded that *Clark* and *Boothby*, either alone or in combination, fail to teach this element substantially as claimed. Page 5, para. 4. However, the Final Office Action suggested that "since Clark teaches the method steps of identifying an occurrence of an event or activity by determining any differences between two files and if the entire file is new, col. 16, lines 4-27, ab] and providing the ability to select at least one item of information contained on said first computing device, for synchronization with a second computing device [col. 3, lines 12-36; col. 16, lines 4-27; ab], the means corresponding to these method steps are inherent in the system in order to perform such method functions." Page 5, para. 4-p. 6, para. 1.

However, *Clark* does not teach or suggest "a work monitor interface, including information identifying an occurrence of an event or activity on the first computing device." Rather, *Clark* (col. 16, lines 4-27) describes scanning two files for differences and activating a "viewer module" so that "the particular differences are highlighted and shown to the user so that he can make a proper decision" (emphasis added). *Clark* identifies differences between a file on a handheld and a file on a host. *Clark* does not identify "an occurrence of an event or activity on the first computing device.@" as recited in Claim 45 (emphasis added). By contrast, *Clark* merely teaches to determine differences

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between the file on the host and the file on the handheld. The files could be different because of changes or modifications made at either machine. Thus, *Clark* merely determines differences between two files, identifying that two files are somehow different. In contrast to Claim 45, *Clark* does not identify an "occurrence of an event or activity on the first computing device," as recited in Claim 45. *Clark* merely identifies that two files are somehow different. Therefore, *Clark* and *Boothby*, alone or in combination, do not teach or suggest each of the limitations of Claim 45. Accordingly, Claim 45 is believed patentable over *Clark* in view of *Boothby*. These arguments were previously submitted in our Response E filed August 20, 2003, and then again in our Response G filed August 20, 2004, but were not addressed in detail in the Final Office Action nor in the latest Office Action.

Claims 46-56 ultimately depend from Claim 45 and should therefore be patentable for at least the reasons discussed above. It is further submitted that Claims 46-56 add their own limitations that render them patentable in their own right. Applicants reserve the right to argue these limitations should it become necessary in the future.

Accordingly, Claims 45-56 are believed patentable under 35 U.S.C. § 103(a) over *Clark* in view of *Boothby* and withdrawal of the Examiner's rejections of Claims 45-56 is requested.

II.   Conclusion

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: __4/28/05__   By: _____
                                                 J. Steven Svoboda
                                                 Reg. No. 44,366

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800